

Applicants: Anna Marie Pyle and Eckhard Jankowsky  
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Examiner's rejections have been overcome, and respectfully request that they be withdrawn.

Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claims 1-8 under 35 U.S.C. §103(a) as allegedly unpatentable over Shuman (Proc. Natl. Acad. Sci. USA, November 1992) in view of Bjornson et al. (Biochemistry, December 1994) and Eggleston et al. (Nucleic Acids Research, April 1996), of record.

In response to the Examiner's rejection of claims 1-8, applicants respectfully traverse, and maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

The rejected claims and cited references have been discussed in applicants' September 10, 2001 Amendment.

To establish a *prima facie* case of obviousness, the Examiner must demonstrate three things with respect to each claim. First, the cited references, when combined, teach or suggest every element of the claim. Second, one of ordinary skill would have been motivated to combine the teachings of the cited references at the time of the invention. And third, there would have been a reasonable expectation that the claimed invention would succeed.

Applicants maintain that the cited references fail to support a *prima facie* case of obviousness of claims 1-8, in that they fail to create a motive to combine or a reasonable expectation of success. In support of this position, applicants incorporate

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herein by reference their remarks in connection with non-obviousness set forth in the September 10, 2001 Amendment.

In view of the above remarks, applicants maintain that the Examiner has failed to set forth a *prima facie* case of obviousness, and that accordingly, claims 1-8 satisfy the requirements of 35 U.S.C. §103(a).

**Conclusion**

Applicants maintain that pending claims 1-8 are in condition for allowance, and respectfully request allowance of these claims.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee, other than the enclosed \$55.00 for a one-month extension of time, is deemed necessary. However, if any additional fee is

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required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:  
Assistant Commissioner for Patents,  
Washington, D.C. 20231.

Alan J. Morrison  
Reg. No. 37,399

5/10/02  
Date

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